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Amendment in Reply to Final Office Action of September 21, 2005
Serial No. 09/736,908REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated September 21, 2005. Reconsideration and allowance of the application in view of the amendments above and the remarks to follow are respectfully requested.

Claims 1-22 are currently pending in the Application. Claims 1, 8, 11, 18, 21, and 22 are independent claims.

In the Office Action, Claims 1-10 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

Applicant respectfully disagrees with and explicitly traverses this ground for rejecting Claims 1-10. It is the Applicant's position that the claims require statutory subject matter. However, in the interest of furthering the prosecution of this matter, Applicant has elected to amend the claims to more clearly state the invention. Specifically, Applicant has amended Claim 1 to more clearly state a method for recommending items using a recommending device ... No new matter is added by this amendment nor should a further search be required as a search of devices has been previously performed. Clearly Claims 1-10 require statutory subject matter. Accordingly, it is respectfully requested that the amendment to the claims be entered and that the rejection of Claims 1-10 be withdrawn.

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Claims 1-22 are rejected under 35 USC§103(a) as allegedly being obvious over U.S. Patent No. 5,758,257 to Herz ("Herz") in view of U.S. Patent No. 5,731,844 (patent number misidentified in Office Action, see top of page 4) to Rauch ("Rauch"). This rejection is respectfully traversed.

Herz shows a system for updating customer profiles by monitoring what is actually watched. As stated in Herz, (emphasis provided) "at step 110, the customers' set top multimedia terminals maintain a record of the video programs that are actually watched by the customer ..." (See, FIG. 1, and accompanying text in Col. 25, lines 37-39). "[A]t step 112, the customers' profiles are updated to reflect the programs actually watched by the customers." (See, Col. 25, lines 45-46.) As further stated in Herz, "the passive monitoring feature of the invention is invoked to determine if the customer actually watched the video program selected ... If the customer watched the predicted program, then the customer profile is presumed accurate at step 308 and no adjustment is made. Of course, the customer profile may be positively reinforced by varying the adjustment increment." (See, FIG. 3, and the accompanying description in Col. 26, lines 57-64.)

Yet the Office Action reads this as disclosing an adjustment "based on a consistency with which an item was selected by a user

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Amendment in Reply to Final Office Action of September 21, 2005 relative to the number of times the item was offered ..." (See, Office Action, page 4, lines 10-12.) As should be clear from the above, Herz merely adjusts a profile in response to shows watched and does not disclose or suggest monitoring a number of times that a show is offered. Accordingly, Herz clearly does not disclose using the number of times a show is offered to adjust a profile.

The Office Action tries to find support for its notion further in columns 31 and 33 of Herz, yet again these areas do not disclose or suggest the present invention as claimed. Herz does adjust the profile when a customer watches shows that are not predicted by the profile (see, Col. 31, lines 6-8). Specifically, the profile of Herz is adjusted when predicted shows are not watched (Col. 31, lines 8-10 and col. 33, lines 24-27) and when shows not predicted are watched (Col. 31, lines 10-12 and col. 33, lines 18-23).

Rauch shows incrementing a counter (704) each time a presented topic is selected by a user (see, FIG. 7, Col. 11, lines 65-67 and Col. 12, lines 12-14). Thereafter, the topics list is reordered and presented to the user based on a number of times the topics are selected (see, FIG. 7, items 706, 708, and Col. 12, lines 16-20).

Accordingly, Rauch similar to Herz, counts a number of times an item is selected and does not maintain a count of a number of times an item is offered.

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The Office Action tries to take a position that "since the list is reordered based on the frequency of a topic selection, the system would inherently have to determine a ratio of the number of times a topic is selected and the number of times the topic was offered in order to determine the rank in the list ... Therefore, no ranking could take place without such a determination." (See, Office Action, page 5, lines 12-17.)

This position is not supported by Rauch. In fact Rauch and Herz for that matter operate by keeping track of items selected without tracking a number of times an item is offered. The ranking is simple, (emphasis provided) "the most frequently selected topic is displayed first, the second most frequently selected topic is displayed second, and so on." (See, Rauch, Col. 12, lines 17-20.) Accordingly, Rauch does not keep track of the number of times an item is offered, inherently or as specifically shown in Rauch.

Applicant respectfully notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art. Mere possibilities or even

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probabilities are not enough; necessity recognized by those of skill in the art is required.¹

In this case, not only are the elements of the claims not inherently required, the prior art teaches a different operation, namely counting a number of times an item is selected!

Accordingly, the method of Claim 1 is not anticipated or made obvious by the teachings of Herz in view of Rauch. For example, Herz in view of Rauch does disclose or suggest, a method that amongst other patentable elements, comprises (illustrative emphasis provided) "calculating an adjustment, A, to said recommendation score, R, based on a consistency which is a ratio of an item being selected by a user relative to the number of times the item was offered; and generating a combined recommendation score, C, based on said recommendation score, R, and said adjustment, A" as

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgirg v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

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required by Claim 1, and as substantially required by each of Claims 8, 11, 18, 21, and 22.

Based on the foregoing, the Applicant respectfully submits that independent Claims 1, 8, 11, 18, 21, and 22 are patentable over Herz in view of Rauch and notice to this effect is earnestly solicited. Claims 2-7, 9, 10, 12-17, 19, and 20 respectively depend from one of Claims 1, 8, 11, and 18 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of said claims. Accordingly, separate consideration and allowance of each of the dependent claims is respectfully requested.

In addition, Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing arguments and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicant reserves the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

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Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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